

REMARKS

In this reply, Claim 27 is canceled and new Claim 28 is added. Thus, Claims 1-26 and 28 are pending in the application. The amendments to the claims do not add any new matter to this application. Each issue raised in the Office action mailed July 18, 2008 is addressed below.

I. ISSUES RELATING TO PRIOR ART

A. ALL CLAIM REJECTIONS BASED ON U.S. PATENT 7,293,081

In the Office action, all claim rejections based on 35 U.S.C. § 103(a) rely in part on the reference U.S. Patent 7,293,081 (“Motoyama II”). These rejections fail to present a *prima facie* case of unpatentability under 35 U.S.C. §103(a) because Motoyama II is not citable in this application under 35 U.S.C. §103(c)(1) and must be removed as a reference.

Under 35 U.S.C. §103(c)(1), as amended by the CREATE Act of 2004, which also extended the applicability of 35 U.S.C. §103(c)(1) to all applications pending on its effective date of December 10, 2004, a reference that qualifies only under 35 U.S.C. §102(e), (f), or (g) is not citable against an application under 35 U.S.C. §103(a) if the invention described in the application for patent and the invention described in the prior art reference applied against the application were commonly owned by, or subject to an obligation of assignment to, the same person, at the time the invention in the application for patent was made. See USPTO “Frequently Asked Questions” about 103(c) at:

<http://www.uspto.gov/web/offices/dcom/olia/aipa/103cfaq.htm>.

The present application is assigned to Ricoh Company, Ltd., as stated in the assignment recorded in the USPTO at reel 015042, frame 0553. The assignee on the face page of Motoyama II is also Ricoh Company, Ltd. Further, at the time that the invention presented in the present

application was made, all inventors were under an obligation to assign any later patent application to Ricoh Company, Ltd., so that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. Motoyama II's filing date is September 12, 2003 and publication date is March 11, 2004; therefore Motoyama II qualifies as a reference only under 35 U.S.C. §102(e) and is not a 102(b) reference to the present application.

Therefore, all requirements of 35 U.S.C. §103(c)(1) are satisfied in the present case with respect to Motoyama II, and Motoyama II is ineligible as a reference. Applicants respectfully request reconsideration and removal of Motoyama II as a reference.

However, Motoyama II is a continuation of U.S. Patent 6,631,247 ("Motoyama I") issued October 7, 2003. Thus it appears that all claim rejections under 35 U.S.C. § 103(a) in the Office action could be made with Motoyama I in place of Motoyama II. Throughout the remainder of this reply, all claim rejections will be treated as if the rejections were made using Motoyama I.

B. CLAIMS 1-4, 9-10, 12-16, 21, 24, AND 27 --- 35 U.S.C. § 103(a)

Claims 1-4, 9-10, 12-16, 21, 24, and 27 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Pat. Pub. 2001/0017700 ("Homma") in view of Motoyama I. The rejection is respectfully traversed.

Claim 1 recites the following (emphasis added):

A multifunction peripheral configured to perform the steps of:
requesting device-related information from a network device over a network;
receiving device-related information from the network device over the network;

generating a device-related report based on said device-related information; and sending said device-related report to a recipient device.

Independent claims 25-26 and 28 contain the same or similar features to the bolded features in Claim 1 above.

The Office Action at page 3 states the following regarding Motoyama II (note that items enclosed in square brackets refer to Motoyama I):

However, Motoyama '081 teaches requesting device-related information from a network device over a network (column 9, lines 1-6 [column 9 lines 4-10], where the service machine request data and where the service machine could be any device, including a multifunction device as stated in column 21, lines 20-23) [column 21 lines 25-28];

receiving device-related information from the network device over the network (column 7, lines 14-16 [column 7 lines 16-18] and column 8, lines 4-16 [column 8, lines 7-19];

With respect to the feature of "**requesting device-related information from a network device over a network**," the Office action points to both column 9 lines 4-10 (describing Fig. 5) and to column 21 lines 25-28 (describing Fig. 25).

First, as shown in Fig. 5, service machine 254 resides behind firewall 250 and functions separately from business office devices 268 and 278. The Office action's reliance on the statement at column 9 lines 8-9 that service machine 254 may be implemented as "any type of device" to equate to a multifunction peripheral as recited in Claim 1 constitutes hindsight reasoning. Fig. 25 and its corresponding text describe a data structure residing on a "printer, copier, or multifunction device," such as business office devices 268 and 278, and not service machine 254.

With respect to the feature of “**receiving device-related information from the network device over the network**,” the Office action points to column 7 lines 16-18 (describing Fig. 3) and to column 8 lines 7-19 (describing Fig.4).

However, the citations to multi-port communication interface 166 in column 7 lines 16-18, column 8 lines 7-19 and Fig. 4 are with reference to an interface on a digital copier, not service machine 254. Thus even if Motoyama I were combinable with Homma, the resulting combination could only perform bits and pieces of Applicants’ claimed method on multiple machines scattered throughout a network, and not on a single multifunction peripheral as appears in Applicants’ claim 1. Accordingly, Applicants respect reconsideration and withdrawal of the obviousness rejections based on Motoyama I.

C. CLAIMS 5-8, 11, 17-20, 22-23, AND 25-26 --- 35 U.S.C. § 103(a)

Claims 5, 20, 22-23, and 25-26 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Homma, in view of Motoyama I, and further in view of U.S. Pat. Pub. 2002/0046247 (“Iwase”).

Claim 6 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Homma, in view of Motoyama I, and further in view of U.S. Patent 6,725,300 (“Nagasaki”).

Claims 7, 11, and 17 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Homma, in view of Motoyama I, and further in view of U.S. Patent 6,347,305 (“Watkins”).

Claim 8 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Homma, in view of Motoyama I, and further in view of U.S. Pat. Pub. 2004/0184108 (“Takano”).

Claim 18 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Homma, in view of Motoyama I, and further in view of WO 01/40907 (“Carter”).

Claim 19 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Homma, in view of Motoyama I, and further in view of U.S. Patent 6,347,306 (“Swart”).

These rejections are respectfully traversed. No combination of one or more of the following {Motoyama I, Homma, Iwase, Nagasaka, Watkins, Takano, Carter, Swart} cures the defects (hindsight reasoning, failure of combination of references to meet claim language) identified with respect to Claim 1 above. Accordingly, each of these claims is patentable at least for the reasons Claim 1 is patentable, and Applicants respectfully request reconsideration and withdrawal of all claim rejections.

D. NEW CLAIM 28

Newly added Claim 28 recites the following:

A multifunction peripheral configured to perform the steps of:
requesting device-related information from a network device over a network;
receiving device-related information from the network device over the network;
reading a meter of the multifunction peripheral to obtain meter information;
generating a device-related report based on the received device-related information and device-related information from the multifunction peripheral; and
sending said device-related report to a recipient device,
wherein the device-related information includes the meter information,
wherein the device-related report includes an identification of the multifunction peripheral.

Applicants submit that new Claim 28 is patentable at least for the reasons Claim 1 is patentable. Additionally, no combination of one or more of {Motoyama I, Homma, Iwase, Nagasaka, Watkins, Takano, Carter, Swart} disclose or suggest Applicants’ claimed feature of

“generating a device-related report based on the received device-related information and device-related information from the multifunction peripheral.” Accordingly, Applicants respectfully submit Claim 28 is in condition for allowance.

II. CONCLUSION

The pending claims not discussed so far are dependent claims that depend on an independent claim that is discussed above. Because each of the dependent claims include the limitations of claims upon which they depend, the dependent claims are patentable for at least those reasons the claims upon which the dependent claims depend are patentable. Removal of the rejections with respect to the dependent claims and allowance of the dependent claims is respectfully requested. In addition, the dependent claims introduce additional limitations that independently render them patentable. Due to the fundamental difference already identified, a separate discussion of those limitations is not included at this time.

For the reasons set forth above, Applicants respectfully submit that all pending claims are patentable over the art of record, including the art cited but not applied. Accordingly, allowance of all claims is hereby respectfully solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a law firm check for the petition for extension of time fee is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: October 15, 2008

/Samuel S. Broda #54802/

Samuel S. Broda
Reg. No. 54,802

2055 Gateway Place Suite 550
San Jose, California 95110-1093
Telephone No.: (408) 414-1080
Facsimile No.: (408) 414-1076